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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,512	12/18/2001	G. Colby Conkwright	37865.010400	1081
22191	7590	10/16/2003	EXAMINER	
GREENBERG-TRAURIG 1750 TYSONS BOULEVARD, 12TH FLOOR MCLEAN, VA 22102			CHAMPAGNE, DONALD	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

10/020,512

Applicant(s)

CONKWRIGHT ET AL.

Examin r

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 January 2003 has been entered.
2. The bases of rejection have been changed somewhat, making some of applicant's remarks moot. The one remark that remains relevant is discussed below at para. 14.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 5 and 7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the remaining claims, does not reasonably provide enablement for "derived user interests" (emphasis added). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. The meaning of "derived" in this context is not clear from the specification. This rejection may be overcome by deleting "derived", thereby amending "derived user interests" to -- user interests --, in each claims 5 and 7.
5. Claims 8 and 13-26 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the remaining claims, does not reasonably provide enablement for a user model derived using an inverse demographic matrix (IDM) method. The specification independently discloses a user model and the IDM method, but does not disclose how the IDM method is used to derive the model. Indeed, the specification does not define user model, which requires the examiner to interpret the term as any description of the user useful for targeting ads or promotions (MPEP § 2111 and 2111.01).

Claim R jections - 35 USC § 102 and 35 USC § 103

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 3, 5-7 and 9-12 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Salgonicoff (US pat. 5,734,720).
9. Salgonicoff teaches (independent claim 1) collecting data associated with at least one set top box (col.6 lines 41-43); deriving at least one *customer profile* (user model) for each set top box based on the collected data (col. 6 lines 46-49); storing the user model for later retrieval (col. 6 lines 61-63 and col. 9 lines 33-37); selecting content and content attributes to be delivered to at least one set top box, delivering said content and attributes to the set top box, and causing the content to be presented by the set top box (*for receipt on the customer's television*) when a correlation (*comparison of customer profiles and content profiles or the agreement matrix determining step*) exists between the content attributes and the user model associated with the set top box (col. 4 lines 57-64, col. 3 lines 8-12 and col. 5 lines 3-6, 10-11 and 59-63).
10. Salgonicoff does not explicitly teach storing an identifier corresponding to the set top box from which the user model is derived. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that the reference does teach polling the set top boxes

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(col. 6 line 65), which would be impossible if an address/identifier for the box had not been stored.

11. Salgonicoff also teaches claim 3 (col. 6 lines 54-55); claim 5 (col. 24 lines 32-34); claims 6-7 (col. 4 lines 49-51); claim 10 (col. 25 lines 3-7); and claim 11 (col. 6 lines 15-39).
12. Salgonicoff also teaches: (claims 9 and 10) that content is changed based on feedback from the customer, including when a program is not selected by the customer (col. 6 lines 41-43 and col. 7 lines 10-12), which reads on repeating the content until the user has experienced said content, and said content must be experienced before user selected content can be experienced.
13. Claim 4 is rejected under 35 U.S.C. 103(a) as obvious over Salgonicoff in view of Jenkins (US pat. 6,285,983). Salgonicoff does not teach transmitting said data to a privacy server, which removes all personally identifiable information from said data before allowing said data to be used. Jenkins teaches (col. 3 lines 22-28) transmitting data to a privacy server, which removes all personally identifiable information from said data before allowing said data to be used. Because Jenkins teaches that the invention overcomes privacy concerns (col. 2 lines 6-10), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Jenkins to those of Salgonicoff.
14. Applicant argues (pp. 7-8) that the combination of Jenkins with Salgonicoff is not justified, in part because Salgonicoff teaches its own encryption scheme for data security. As noted in para. 13 above, the justification for combining Jenkins with Salgonicoff is in Jenkins, not in Salgonicoff. Salgonicoff teaches a system of transmission security (col. 43 lines 4-11). It is fully compatible with the teaching of Jenkins. The Jenkins invention can only begin protecting the data when it reaches the privacy server. Anyone very concerned with information security would also want to encrypt it in transmission, as Salgonicoff teaches.
15. Claims 8, 13-15 and 19-22 are rejected under 35 U.S.C. 103(a) as obvious over Salgonicoff in view of Gerace (US pat. 5,848,396). Salgonicoff does not teach that the user model is derived using an inverse demographic matrix (IDM) method. Gerace teaches (col. 2 lines 43-48) a user model derived using "regression analysis", which reads on an inverse demographic matrix (IDM) method. Because regression analysis/IDM is commonly known to be a very efficient means for summarizing data, it would have been obvious to one of

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ordinary skill in the art, at the time of the invention, to add the teachings of Gerace to those of Salgonicoff.

16. Claims 16-18 and 23-26 are rejected under 35 U.S.C. 103(a) as obvious over Salgonicoff in view of Jenkins and Gerace, for the reasons given in para. 13-15 above. Independent claim 16 is essentially a combination of claims 4 and 8, and independent claim 23 is essentially a combination of claims 4, 8 and 9.

Suggestion of Allowable Subject Matter

17. Gerace gives no details as to how to derive a user model with regression/IDM. If, and this is a big if, applicant can clarify how his invention derives a user model with a regression/IDM method, without adding new matter, and thereby satisfying the enablement rejection (para. 5 above), then the application might be made patentable by narrowing the claims. Applicant should be aware that allowance would depend on the results of searching the new claims.

Conclusion

18. **COPY of REFERENCES** - Applicant is entitled to receive a copy of every reference cited by the examiner (except at allowance; MPEP 707.05(a)). Applicant should contact the examiner if a completed form PTO-892 is enclosed, but the cited references are not.
19. It is convenient to use the published copy of the application, US 2002/0133490 A1, as a reference. A copy with the examiner's notes is enclosed for applicant's convenience.
20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
21. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

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22. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

A handwritten signature in black ink, appearing to read "Donald L. Champagne", written over a horizontal line.

Donald L. Champagne
Examiner
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11 October 2003